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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,365	03/09/2004	Roger Dean Neitzell	066042-9276-04	2254
60840 7590 08/31/2007 MICHAEL, BEST & FRIEDRICH LLP 100 EAST WISCONSIN AVENUE SUITE 3300 MILWAUKEE, WI 53202			EXAMINER PAYER, HWEI SIU CHOU	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 08/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,365

Applicant(s)

NEITZELL ET AL.

Examiner

Hwei-Siu C. Payer

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

The amendment filed on 6-15-2007 has been entered.

Claims Rejection - 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (U.S. Patent No. 6,021,573) in view of Nagel (U.S. Patent No. Des. 377,303).

Kikuchi et al. show a reciprocating saw comprising a housing (14) having a body and a hand grip integrally formed with the body; the body housing a motor (44) and a drive mechanism (16); a reciprocating spindle (21) for supporting a tool element (46); the drive mechanism (16) being operably connected to the spindle (21) for causing reciprocation of the spindle (21); a switch assembly (42) operable to electrically connect the motor (44) to a power source (38); a wiring arrangement (unnumbered, see Fig. 1) electrically connecting the switch assembly (42) to the motor (44) substantially as claimed except the body and the hand grip are of one single piece (14) and therefore not adjustable with respect to each other.

Nagel teaches that it is desirable to provide a power tool that is adjustable into three different positions, a first position in which the tool body and the hand grip are generally aligned (see Fig.8), a second position in which the tool body and the hand grip are at an obtuse angle (see Fig.7), and a third position in which the tool housing and the hand grip are generally perpendicular to each other (see Fig.2).

Therefore, it would have been obvious to one skilled in the art to modify Kikuchi et al. by having the one piece housing formed of two separated pieces, namely a body and a hand grip, and adjustably connecting the two pieces together so that they are angularly adjustable in a plurality of different positions to facilitate the use of the power tool in a confined working area as taught by Nagel.

3. Claims 2-8, 10, 13-19, 21, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (U.S. Patent No. 6,021,573) and Nagel (U.S. Patent No. Des. 377,303) as applied to claims 1, 12 and 23 above, and further in view of Alsrue (U.S. Patent No. 6,102,134).

The power tool of Kikuchi et al. as modified above shows all the claimed structure except it lacks a locking mechanism, an actuator, and a biasing means.

Alsrue teaches providing a power tool with a locking mechanism having recesses (46,48) and a projection (90) engageable in a selective one of the recesses (46,48) for locking the hand grip (14) of the power tool in a plurality of different positions; an actuator (70) for moving the locking mechanism between a locked condition and an

unlocked condition; and means (80) for biasing the locking mechanism toward a locked condition.

Therefore, it would have been obvious to one skilled in the art to further modify Kikuchi et al. by providing the power tool with a locking mechanism, an actuator, and a biasing means for adjusting the hand grip with respect to the housing of the power tool as taught by Alsrue.

4. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (U.S. Patent No. 6,021,573) and Nagel (U.S. Patent No. Des. 377,303) as applied to claims 1 and 12 above, and further in view of Yang (U.S. Patent No. 4,976,173).

The power tool of Kikuchi et al. as modified above shows all the claimed structure except the power tool is powered by a battery (38) contained in the power tool rather than by an external power source via a cord.

However, it is well known in the art to use a power cord for supplying an external energy source to a power tool as evidenced by Yang (see column 3, lines 40-42).

Since both Kikuchi et al. and Yang teach methods of powering a power tool, it would have been obvious to one skilled in the art to substitute the power cord of Yang for the battery of Kikuchi et al. to achieve the predictable result of powering a power tool.

Remarks

Applicant's arguments with respect to claims 1-10, 12-21 and 23-26 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue the fact that the body and the hand grip of the power tool of Kikuchi are integrally formed teaches away from the modification suggested by the Examiner. Examiner disagrees that it is the case. Kikuchi et al. merely shows the body and the hand grip are not adjustable with respect to each other. Kikuchi et al. do not explicitly mention adjustability is undesirable. Further, it has been held that the provision of adjustability, where needed, involves only routine skill in the art. In re Stevens, 101 USPQ 284, CCPA 1954.

wp Applicants further argue the structural differences between the reciprocating saw of Kikuchi and the ^{drill} ~~file~~ of Nagel and the screw driver of Alsrue are significant, and these differences present significantly different design considerations, making the suggested combination of the teachings of Kikuchi and Nagel and /or Alsrue inappropriate.

In response, inasmuch as Nagel and Alsrue are directed to hand-held electrical tools, their collective teachings would have suggested and, thereby, rendered obvious the use of a moveable/adjustable handle for the reciprocating saw of Kikuchi et al. to facilitate the use of the hand tool in a confined working area. While it is appreciated, as emphasized by the Applicants, that the dynamics of drilling and sawing are different, Applicants have not satisfactorily explained how such differences would

have dissuaded one of ordinary skill in the art from employing a movable, adjustable handle with a reciprocating saw.

In response to applicants' argument that the components of the drive mechanism of Kikuchi et al. could not be housed in a two-piece housing having a hand grip movable relative to a body, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Action Made Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

H Payer
August 28, 2007

/Hwei-Siu C. Payer/

Primary Examiner, Art Unit 3724